

IN THE DRAWINGS

The attached sheet of drawings includes changes to Figs. 1-4. These sheets, which include Figs. 1-4, replace the original sheets including Figs. 1-4.

Attachment: Replacement Sheets

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 11, 13-18, and 24 are pending in the present application, Claims 11 and 15, 17 having been amended, Claim 24 having been added; Claims 14 and 18 having been withdrawn as being directed toward a non-elected species; and Claims 12, 16, and 19-23 having been canceled without prejudice or disclaimer. Support for the amendments to Claims 11, 15, and 17 is found, for example, in Applicants Fig. 6 and pages 12 and 13 of the originally filed specification. Support for Claim 24 is found in original Claim 11. Applicants respectfully submit that no new matter is added.

In the outstanding Office Action, the drawings were objected to; Claims 11-13 and 15-17 were rejected under 35 U.S.C. §112, second paragraph; Claims 11, 12, 15, and 16 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over JP 2000-274990 (hereinafter '990) or Applicants' conceded prior art Fig. 3; Claims 11, 12, 15, and 16 were rejected under 35 U.S.C. §103(a) as unpatentable over '990 or Applicants conceded prior art Fig. 3 in view of Klute (U.S. Patent No. 2,922,441) or Peirasso (U.S. Patent No. 7,073,576); Claims 11, 13, and 17 were rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over JP 2000-234566 (hereinafter '566); and Claims 11-13 and 15-17 were rejected under 35 U.S.C. §103(a) as unpatentable over JP 11-280563 (hereinafter '563) in view of any one of JP 2000-292089 (hereinafter '089), JP 2000-283666 (hereinafter '666), and JP 55-14905 (hereinafter '905).

With respect to the objection to the drawings, Figs. 1-4 are amended to include a legend of "Prior Art." Applicants respectfully request that the objection to the drawings be withdrawn.

With respect to the Examiner's request for a translation of JP 55-14905, a translation is submitted herewith. The reference numerals 11-14 are not discussed in the description.

With respect to the rejection under 35 U.S.C. §112, second paragraph, Applicants respectfully submit that the amendment to Claim 11 overcomes this ground of rejection. Claim 11 is amended to more clearly describe and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully submit that the rejection under 35 U.S.C. §112, second paragraph, is overcome.

As an initial matter, it is noted that MPEP §706.02 II is relevant to rejections based on English Abstracts and/or the underlying foreign language document. This MPEP section makes it clear that if the Examiner is relying on both the English Abstract and the underlying Japanese document, a translation of this document is to be obtained and supplied prior to implementing a final Action. As the present Action includes no translation of the underlying document, the outstanding Office Action must be relying on the English Abstracts alone. However, MPEP §707.02 II makes it clear that such reliance is "inappropriate where both the abstract and the underlying document are prior art."

Accordingly, it is respectfully submitted that the present Action that must be relying only on the English Abstracts is inappropriate and should be withdrawn. Furthermore, to the extent that any subsequent Action relies on a non-English language document, a copy of the full translation should be supplied as required under MPEP §706.02 II. ***See also Ex Parte Gavin, 62 USPQ2d 1680, where the Board of Patent Appeals and Interferences placed the burden of obtaining a translation on the Examiner.***

Applicants respectfully submit that amended Claim 11 recites novel and non-obvious elements. Amended Claim 11 recites, *inter alia*,

An EGR cooler comprising:
tubes;

a shell enclosing said tube;

a cooling water inlet, attached to an end of the shell, to supply cooling water into said shell;

a cooling water outlet, attached to another end of the shell, to discharge the cooling water from said shell;

a guide, attached to said shell, to guide gas into said tubes for thermal exchange of said gas with said cooling water; and

a bypass flow path, arranged in said shell, to guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit.

The references cited by the outstanding Office Action do not disclose or suggest the claimed “a bypass flow path, arranged in said shell, to guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit.”

Fig. 3 of the ‘990 reference shows a bypass flow path 17 that is outside of the casing 1. Thus, the ‘990 reference does not disclose or suggest the claimed “*a bypass flow path, arranged in said shell*, to guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit” (emphasis added).

Applicants’ Fig. 3 shows a bypass flow path 14 that is outside of shell 1. Thus, Applicants’ Fig. 3 does not disclose or suggest the claimed “*a bypass flow path, arranged in said shell*, to guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit” (emphasis added).

Furthermore, Klute does not cure the above-noted deficiencies in the ‘990 reference or Applicants’ Fig. 3. The outstanding Office Action is vague with respect to what element of the claims Klute is believed to suggest. Klute merely describes a fitting adapted to be inserted into a line of a forced feed circulatory system.¹ Fig. 1 of Klute shows how hot water may flow through hot water radiator 25. However, Fig. 1 of Klute merely shows tubes and

¹ Klute, col. 1, lines 15-17. See also, Fig. 1, element 15, and Figs. 5 and 6 where fitting 30 is inserted into pipe 5.

baffle plates. Klute does not disclose or suggest “a bypass flow path, arranged in said shell, to guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit.”

Furthermore, Peirasso does not cure the above-noted deficiencies in the ‘990 reference or Applicants’ Fig. 3. Peirasso describes a circulation system for coolant in an oil cooler. The system shown in Peirasso shows a radiator 4 provided with an expansion tank for the coolant 5, a thermostat 6 connected to the radiator 4 by a delivery conduit 7 and a return conduit 8. The return conduit further connects the thermostat 6 to pump 9.² Peirasso does not disclose or suggest “a bypass flow path, arranged in said shell, to guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit.”

Furthermore, Applicants note that the claimed “a bypass flow path, arranged in said shell, to guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit” is advantageous. The invention defined by Claim 11 has the advantage that the cooling water is properly guided to prevent water stagnation zones from being generated. If the baffles or radiators of Klute or Peirasso are used, water stagnation zones will be generated at the corners of the baffles or radiators.

As the ‘990 reference, Applicants Fig. 3, Klute and Peirasso do not disclose or suggest the claimed “a bypass flow path, arranged in said shell, to guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit,” Applicants respectfully submit that a person of ordinary skill in the art could not properly combine the ‘990 reference, Applicants Fig. 3, Klute and Peirasso to arrive at the invention defined by Claim 11. Thus, the rejections based on the ‘990 reference, Applicants Fig. 3, Klute and Peirasso are traversed.

² Peirasso, col. 1, lines 48-54.

With respect to the rejection of Claim 11 based on the '566 document, the outstanding Office Action is vague with respect to why the elements of Claim 11 are believed to be in the '566 document. The English abstract provided by the Office merely states "Several cooling medium inflow pipes (1-1b) are provided on the exhaust recirculation gas EGR inflow side of casing (1)." As shown in the figures of the '566 reference, pipes (1-1b) are outside of the casing 1.

The outstanding Office Action states "The spaces where these tubes are 'missing' in Figure 3(B) extend along the inside of the shell and constitute the bypass flow path." However, the Office provides no support for this position. The position of the Office is mere speculation. The Office is called upon to identify the authority upon which it relies to support the use of mere speculation as a basis for rejection. In this regard, it is noted that substitution of an improper subjective conclusion as to knowledge in the art for concrete evidence of such knowledge relative to a core factual finding required for a determination of patentability is clearly improper. See In re Zurko, 59 USPQ2d 1693, 1697-98 (Fed. Cir. 2001) as follows:

As an administrative tribunal, the [PTO] clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the [PTO] cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge or common sense. Rather, the [PTO] must point to some concrete evidence in the record in support of these findings. [Emphasis added.]

Figure 3(b) of the '566 reference clearly shows that pipes 1-1c are outside of the casing 1. There is no bypass flow path, which includes a bypass conduit, arranged inside casing 1, which guides the cooling water to a direction diametrically opposite to the inlet. Thus, the '566 reference does not disclose or suggest the claimed "a bypass flow path,

arranged in said shell, to guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit.”

Thus, the rejection based on the '566 patent is traversed.

With respect to the rejections based on the '563, '089, '666, and '905 references, these rejections are respectfully traversed.

Fig. 10 of the '563 patent shows a sectional side view of an EGR cooler. As is seen from Fig. 10 of the '563 patent, there is no “a bypass flow path, arranged in said shell, to guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit.”

The outstanding Office Action takes the position that Figs. 4-9 of the '089 reference describe bypass path F. However, element F does not guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit. Element F is merely a hole in a baffle plate. The '089 reference merely includes tubes and baffle plates, and fails to appropriately guide cooling water. The baffle plates of the '089 reference will cause water stagnation zones at the corners of the baffle plates.

The outstanding Office Action takes the position that Fig. 2 of the '666 references describes bypass 6. However, element 6 does not guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit. Element 6 is merely a hole in a baffle plate. The '666 reference merely includes tubes and baffle plates, and fails to appropriately guide cooling water. The baffle plates of the '666 reference will cause water stagnation zones at the corners of the baffle plates.

The outstanding Office Action takes the position that Figs. 3-4 of the '905 reference describes bypass pipe 14. The outstanding Office Action states “with what appears to be bypass pipe 14.” Again, the Office is improperly relying on speculation as basis for rejection. Element 14 is not a bypass pipe. On the contrary, element 14 is merely a connecting bar.

As the '563, '089, '666, and '905 references do not disclose or suggest the claimed "a bypass flow path, arranged in said shell, to guide the cooling water to a direction diametrically opposite to the inlet, wherein the bypass flow path includes a bypass conduit," Applicants respectfully submit that a person of ordinary skill in the art could not properly combine the '563, '089, '666, and '905 references to arrive at the invention defined by Claim 11. Thus, the rejections based on the '563, '089, '666, and '905 references are traversed.

In view of the above-noted references, Applicants respectfully submit that Claim 11 (and any claims dependent thereon) patentably distinguish over the references cited by the Office.

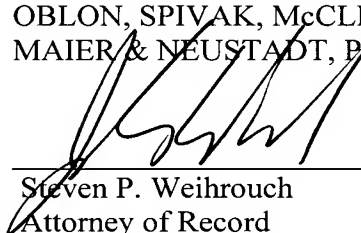
Moreover, withdrawn Claims 14 and 18 should be rejoined and allowed with Claim 11, from which they depend.

New Claim 24 recites elements similar to those of Claim 11. Thus, Claim 24 patentably distinguishes over the cited references for at least the reasons stated for Claim 11.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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